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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 09/902,321

Filing Date: July 10, 2001

Appellant(s): VATTER ET AL.

Kenya Pierre
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/10/03.

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(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-14 stand or fall together.

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

Hawley, G.G., The Condensed Chemical Dictionary, 10th Ed., Van Nostrand Reinhold Col., New York (1981) pages 121, 385, 434, and 686.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tachibana et al. (5,412,004).

Tachibana is directed to the manufacture of paste-like silicone compositions that can be used in water-in-oil cosmetic emulsions (title and abstract, in a water-in-oil emulsion, water is the discontinuous phase and oil is the continuous phase). Appellant discloses at page 5, lines 4-11 and page 6, lines 12-14 that the emulsifying crosslinked siloxane elastomers are those disclosed by Tachibana. The water-in-oil cosmetic emulsion of Tachibana may contain various components in the discontinuous phase such as saccharides, sugar alcohols, inorganic salts, polyoxyalkylene-modified organopolysiloxane emulsifiers (surfactants) and cosmetic powders, such as talc, kaolin, mica, titanium dioxide, zinc oxide, red iron oxide, and others (col. 3, line 55 to col. 4, line 18, and Col. 10, line 61-Col. 11, line 6). For solids such as organically modified montmorillonite clay, see col. 8, lines 38-47. For sorbitol, a polyhydric alcohol of claim 4, see

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col. 9, lines 28-29. For dimethicone copolyol emulsifier, see col. 9, line 38 to col. 10, line 53.

For additional solids and fillers, see col. 10, line 57 to col. 11, line 6. For preservatives and skin conditioning agents such as moisturizers, which encompasses emollients, see col. 11, lines 53-57. See examples 15+ for preservatives and forms of the compositions such as foundation, eye shadow, and rouge (blusher).

Tachibana discloses at col. 7, lines 33-39 that the paste-like composition comprises 100 parts by weight of the silicone polymer (emulsifying siloxane elastomer) and 10-1000 parts by weight of a silicon oil. This is equivalent to 9-90 wt.% of each of the components, which overlaps the instantly claimed percent ranges of claim 14.

Tachibana does not disclose the droplet size distribution range of the discontinuous phase, the average particle size of the emulsifying crosslinked siloxane elastomer, or the amount of air contained in the composition. It is within the skill in the art to select optimal parameters in a composition in order to achieve a beneficial effect. In re Boesch, 205 USPQ 215 (CCPA 1988). Therefore, absent evidence of unexpected results, it is considered within the skill in the art to select optimal droplet size and particle size in the compositions of Tachibana for aesthetic purposes. Applicants admit at page 20, lines 8-13 that the compositions may be aerated by hand or mechanical mixing as well as any conventional form of foaming or whipping. It is the Examiner's position that simple stirring would incorporate an amount of air of at least 1% in the compositions. Therefore, the compositions of Tachibana necessarily contain at least about 1% air as instantly claimed. Burden is shifted to Appellant to show that the compositions of Tachibana do not contain the instantly claimed amount of air.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to select an optimal droplet size of the discontinuous phase and particle size of the emulsifying siloxane elastomer in the compositions of Tachibana expecting to obtain stable cosmetic water-in-oil emulsions that provide good feeling upon use.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tachibana et al. as applied to claims 1-10 and 12-14 above, and further in view of Hawley, G.G., The Condensed Chemical Dictionary, 10th Ed., Van Nostrand Reinhold Col, New York (1981) pages 121, 385, 434 and 686.

Tachibana teaches all the limitations of the claims as stated in the 35 USC 103(a) rejection above. It does not teach the preservatives of instant claim 11. Tachibana does teach that the composition contains preservatives. The preservatives of instant claim 11 are conventional substances used in the cosmetic art. According to Hawley, disodium ETA, phenoxyethanol and methylparaben are all known preservatives. Benzyl alcohol is also known for use in cosmetics.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add anyone of the preservatives above to the composition of Tachibana for their known antimicrobial effects.

(11) Response to Argument

Appellant argues, "The reference, however, fails to teach or suggest a composition as Appellants currently claim that includes a solid particle-containing discontinuous phase wherein the discontinuous phase has a droplet size distribution range of from 0.1 microns to 100 microns". This argument is not persuasive. First, the Examiner respectfully points out that Col.

10, line 61-Col. 11, line 6 of Tachibana teaches solid particles contained within the discontinuous phase (wherein the water phase is the discontinuous phase in Tachibana et al). Second, regarding the particle size, it is respectfully pointed out that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233) and that a change in size is generally recognized as being within the level of ordinary skill in the art (*In re Rose*, 105 USPQ 237 (CCPA 1955)).

Appellant argues, “Moreover, the reference fails to teach or suggest that such particles are uniformly distributed on the skin independent of skin topography”. This argument is not persuasive. It is respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the intended use of the composition is not given patentable weight.

Appellant argues, “Appellants have found that the solid particles, when in the discontinuous phase, are dispersed within and/or at the droplet interface of the emulsions system such that the capillary induced agglomeration of the particles is confined within the space or volume occupied by the droplet, thereby providing a more even distribution of the broad range of particles on skin. Additionally, the droplets serve as a barrier preventing agglomeration as a result of application shear which provides a more uniform look upon application. These

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principles/observations are not disclosed expressly or implicitly in the Tachibana reference”.

This argument is not persuasive. First, this argument is not commensurate in scope with the instant claims, as the claims do not recite such properties of capillary induced agglomeration, or even distribution of the particles on the skin. Second, Appellant has provided no unexpected results in either the specification or in the form of a declaration. As suggested in the Advisory Action mailed 8/12/03, Appellant should have provided unexpected results comparing the instant invention with the closest prior art (Tachibana et al.) in accordance with MPEP 706.02, if the instant invention truly achieves unexpected results.

Appellant argues, “Tachibana fails to teach or suggest the delivery of powder or pigmented solids via the discontinuous phase of an emulsion composition. The Office identifies that Tachibana discloses solids selected from the group consisting of sugars, sugar alcohols, and inorganic salts for use in the water phase of the composition. Appellants respectfully submit that Tachibana’s solids are contrary to the presently claimed invention because Tachibana’s water-soluble actives would prevent uniform deposition of such particles on the skin”. This argument is not persuasive. First, it is respectfully pointed out that this argument is not commensurate in scope with the instant claims, as the instant independent claims do not recite powder or pigmented solids. Second, as previously pointed out, the intended use of the composition is not given patentable weight. Third, it is respectfully pointed out that Col. 10, line 61-Col. 11, line 6 of Tachibana, teach powder/pigmented solids, as recited in instant claim 9, in the discontinuous phase. Thus, Tachibana’s solids are indistinguishable from those of the instant invention.

Appellant argues, “Solids, such as those taught by Appellants’ invention, can be identified as those that not only exhibit an average particle size less than 20 microns but are also

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insoluble in order to provide optimal delivery to the skin. Further, Tachibana would fall short of achieving Appellant's desired deposition pattern since Tachibana fails to teach or suggest the distribution of the solid particles in the discontinuous phase within and/or at the droplet interface of the emulsion system as presently claimed". This argument is not persuasive. First, the argument is not commensurate in scope with the instant claims, which do not recite solid particles at the droplet interface, an average particle size of less than 20 microns, or insoluble particles. Second, as previously pointed out, the intended use of the composition is not given patentable weight. Third, it is respectfully pointed out that Tachibana et al. teach the same solid particles in Col. 10, line 61-Col. 11, line 6 in the discontinuous phase, as that recited in instant claim 9.

Appellant argues, "Appellants respectfully submit that one skilled in the art reading Tachibana would not appreciate the aesthetic and functional attributes achieved by Appellants' claimed invention". This argument is not persuasive as it is not commensurate in scope with the instant claims, and because Appellant has provided no unexpected results to differentiate these properties from those of Tachibana et al.

Appellant argues, "a skilled artisan reading Tachibana would find that if cosmetic powders are used, they are to be deposited solely in the external, oil phase resulting in a shear dependent continuous deposition". This argument is not persuasive. As pointed out in the above paragraphs, Tachibana et al. specifically teach the cosmetic powder of instant claim 9, as incorporated into the discontinuous phase (water phase) of their water-in-oil emulsion.

Appellant argues, "Appellants respectfully submit that the Office has rejected the aforementioned claims under an assertion of obviousness yet relied on a rationale of inherency".

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This argument is not persuasive, as the instant rejection, does not rely upon inherency in any way. Furthermore, Appellant has not disclosed where the instant rejection supposedly relies upon inherency.

The instant claims are directed toward an emulsion comprising a continuous phase of an emulsifying crosslinked siloxane elastomer and a solvent for the elastomer, and a discontinuous phase comprising solid particles, wherein the droplet size distribution range of the particles is from 0.1-100 microns. Tachibana teaches water-in-oil compositions, wherein solid particles are taught in the discontinuous, water phase (Col. 10, line 61-Col. 11, line 6), and Appellant discloses at page 5, lines 4-11 and page 6, lines 12-14 of the specification that the emulsifying crosslinked elastomers of the instant invention are those disclosed by Tachibana, wherein these elastomers are located in the continuous, oil phase of Tachibana. While the particle size of the solid particles is not explicitly taught in Tachibana, for the reasons discussed above, it is obvious and within the skill of the artisan to vary particle size.

In Appellant's arguments over claim 11, Appellant's provide no new arguments, but restate arguments over claims 1-10 and 12-14, which the Examiner has addressed in the above paragraphs.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Additionally, it is respectfully pointed out that Tachibana et al. (col. 11, line 55) teach addition of preservatives, thereby motivating one of ordinary skill in the art to employ cosmetically acceptable/conventional preservatives.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Lauren Wells
Lauren Wells
November 14, 2003

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